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MUETING, RAASCH & GEBHARDT, P.A.  
P.O. BOX 581415  
MINNEAPOLIS, MN 55458

EXAMINER

BISSETT, MELANIE D

ART UNIT PAPER NUMBER

1711

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/000,057

Applicant(s)

DARGONTINA ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The rejections based on 35 USC 103 have been maintained or altered. The rejection based on 35 USC 112 has also been altered to reflect the amended claim.

***Election/Restrictions***

2. Newly submitted claims 26-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new method claims present a method of stacking siding products, where the elected method is drawn to a method of forming a siding product. The methods are independent and distinct from each other since the methods form different products.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant's election with traverse of group II, claims 17-20 in the paper filed 7/22/03 is acknowledged. The traversal is on the ground(s) that a separate examination of the two groups would require duplication of work since the categories are interrelated. This is not found persuasive because the examiner has pointed to the separate classification required for each group. A search for the method would not require a search in multi-layer product subclasses. Also note that a search for the method does not require a search for the two siding stacks. Thus, the search strategies required are unique to the inventions.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "acceptable appearance" in claim 20 is a relative term which renders the claim indefinite. The term "acceptable appearance" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Although the examples of the specification show that the minimum "acceptable appearance" should have only "some decrease in gloss and minor loss of coating", it is unclear what differentiates "some decrease in gloss" from "severe decrease in gloss" or "minor loss in coating" from "some loss in coating". Thus, the claim is indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 17-18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. ('778).

9. Takahashi '778 discloses a decorative material including a substrate and an abrasion-resistant coating layer (abstract). Example substrates include fiber-cement boards such as pulp-cement and wood chip-cement boards (col. 2 lines 45-65). Note that the making of a "fiberboard cement siding product" is deemed an intended use. Thus, since a coated fiberboard cement product could be used as a siding product, it is the examiner's position that this limitation is anticipated by the reference. Decorative patterns are printed (or coated) onto the fiberboard surface and the scratch-resistant coating is applied thereon (col. 10 lines 57-66). The scratch-resistant coating comprises an ionizing-radiation-curing resin including polyurethanes, epoxies, acrylics (col. 5 line 64-col. 6 line 7). Thus, temperatures in excess of 80 °C are not needed. Coating thicknesses range from 20-25 µm (examples). Because the materials are noted as having excellent scratch resistance and because the coating materials comprise the same binders as those of the applicant's claims, it is the examiner's position that the coatings of the reference would inherently possess the applicant's claimed appearance.

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10. Claims 17-18 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. ('352).

11. Takahashi '352 discloses a decorative material including a substrate and an surface protective coating layer (abstract). Example substrates include fiber-cement boards such as pulp-cement and wood chip-cement boards (col. 3 lines 7-29). Note that the making of a "fiberboard cement siding product" is deemed an intended use. Thus, since a coated fiberboard cement product could be used as a siding product, it is the examiner's position that this limitation is anticipated by the reference. Decorative patterns are printed (or coated) onto the fiberboard surface and the scratch-resistant coating is applied thereon (col. 7 lines 54-61; figures). The scratch-resistant coating comprises an ionizing-radiation-curing resin including polyurethanes, epoxies, acrylics (col. 3 lines 37-55). Thus, temperatures in excess of 80 °C are not needed. Preferred coating thicknesses range from 5-30 µm (col. 7 lines 1-2). Because the materials are noted as having excellent scratch resistance and because the coating materials comprise the same binders as those of the applicant's claims, it is the examiner's position that the coatings of the reference would inherently possess the applicant's claimed appearance.

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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13. Claims 17-18 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pears et al. ('827) in view of Pears et al. ('925).

14. Pears '827 discloses a coating material on a fiberboard cement substrate (col. 11 line 47), where the coating may include dyes and pigments (col. 11 line 52). However, the reference does not specify the use of an additional protective layer. Pears '925 teaches a polyurethane polymer dispersion coating for forming protective coatings on various substrates (col. 1 lines 10-18; abstract). Substrates include wood, metals, glass, paper, plastics, and foam (col. 17 lines 39-52). The coatings have improved film hardness, solvent resistance, and corrosion resistance (col. 17 lines 30-38). Crosslinking is affected by radiation or air oxidation (col. 16 lines 49-61); thus, temperatures in excess of 80 °C are not needed. Since Pears '827 is concerned with providing coatings on similar substrates (col. 11 lines 42-51), it is the examiner's position that it would have been prima facie obvious to combine the two teachings to provide a substrate having a decorative layer and a topcoat layer, where the topcoat layer provides extra protection against solvents and corrosion. Although the coating thickness is not specified, it is the examiner's position that it would have been prima facie obvious to coat the material at any thickness necessary to obtain optimum film hardness, solvent resistance, and corrosion resistance properties.

15. Regarding the applicant's claimed appearance, because the materials are noted as having excellent mar resistance (examples) and because the coating materials comprise the same binders as those of the applicant's claims, it is the examiner's

position that the coatings of the reference would inherently possess the applicant's claimed appearance.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of Takahashi '778 and '352 in view of Harper et al.

17. The Takahashi references apply as above, noting the use of cement fiberboard substrates but failing to note the distinct compositions of those substrates. Harper discloses non-asbestos corrugated sheets comprising amounts of silica, cement, and cellulose fibers to form sheets suitable for external cladding and roofing (abstract). The densities of the sheets exceed  $1400 \text{ kg/m}^3$  ( $1.4 \text{ g/cm}^3$ ) (col. 3 lines 1-4). These sheets have improved strength and durability for asbestos-free products (col. 1 lines 48-52). Thus, it is the examiner's position that it would have been prima facie obvious to use the substrates of Harper's invention for the composites of Takahashi to produce a product having improved strength and durability.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pears et al. '827 in view of Pears et al. '925 as applied to claims 17-18 and 20-25 above, and further in view of Harper et al.

19. The Pears references apply as above, noting the use of cement fiberboard substrates but failing to note the distinct compositions of those substrates. Harper discloses non-asbestos corrugated sheets comprising amounts of silica, cement, and cellulose fibers to form sheets suitable for external cladding and roofing (abstract). The



densities of the sheets exceed  $1400 \text{ kg/m}^3$  ( $1.4 \text{ g/cm}^3$ ) (col. 3 lines 1-4). These sheets have improved strength and durability for asbestos-free products (col. 1 lines 48-52). Thus, it is the examiner's position that it would have been prima facie obvious to use the substrates of Harper's invention for the composites of Pears to produce a product having improved strength and durability.

### ***Response to Arguments***

20. In response to the applicant's arguments that phrases in the claims need not be art recognized or defined, see MPEP 706.03(d) and 2173.05(a), which state that these are in fact the requirements to be met by the applicant.

21. In response to the applicant's arguments that Takahashi '352 does not teach the applicant's claimed siding product, it is the examiner's position that the reference anticipates each and every limitation of the claims, as pointed out above. The applicant has not shown how these limitations are not met.

22. Regarding the applicant's argument that there is no motivation to modify the primary reference to provide a scratch resistant coating, it is the examiner's position that it would have been prima facie obvious to include a further protective coating on the material of the Pears '827 invention to amplify the benefits of a protective coating. The topcoat layer provides extra protection against solvents and corrosion.

23. In response to the applicant's argument that there is no reasonable expectation of success of combining the references, it is noted that both references teach coating similar substrates. The Pears '925 reference also teaches coating plastic substrates.

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Thus, the application of a protective coating onto a polymeric surface is envisioned and expected to succeed.

24. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539 or (571) 272-1068 after December 2003. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
RABON SERGENT  
PRIMARY EXAMINER